IN THE HIGH COURT OF JUDICATURE AT BOMBAY

O.O.C.J.

NOTICE OF MOTION NO. 2685 OF 2003

IN

SUIT NO. 2898 OF 2003

Bharati Cellular Ltd and anr. ....Plaintiffs.
vs.
Jai Distillers P.Ltd ....Defendants.

Virag Tulzapurkar with Amit Jamsandekar,
Sindhu Shrivastav and Ms. Neha Phatak
i/by. D.H. Law and Associates
for the plaintiffs.
in support of Notice of Motion.

Salil Shah with Hemang Engineer and
Ms. Avani Shah i/by. Gordhandas and Fozdar
for the defendants.

CORAM: S.U.KAMDAR, J.

DATED: 21ST MARCH,2006.

JUDGMENT :

1. The present notice of Motion has been taken out interalia seeking relief of injunction

of infringement of the plaintiffs artistic work being Exhibit-D to the plaint and also for an injunction from in any manner manufacturing, marketing, exhibiting and selling any goods bearing the trade mark ‘AirTel’ as mentioned in Exhibit-A and B to the plaint or any other deceptively similar mark on the ground of passing off. Prayer (c) and (d) of the motion are for appointment of the court Receiver with a power to take possession of the goods and destruct all the labels, cartons and advertising material.

2. Some of the material facts of the present case are as under :

3. The plaintiffs are a company inter-alia carrying on business in telecommunication services. The plaintiffs are also providing mobile services to various people in India and is a well known company in the name of ‘AirTel’. The plaintiffs are carrying on business in various states of India and are having a large turnover and are owner of well known popular brand name

'AirTel'. Sometime in or about 1994 the plaintiffs conceived and invented the word mark 'AirTel'. The plaintiff have also simultaneously adopted a distinctive label mark consisting the word 'AirTel' written in a particular manner with a particular colour combination. Plaintiffs are also contending that they are a group of companies who are using the said mark 'AirTel' essentially in relation to business of telecommunication services. The plaintiffs have also contended that they have acquired a super reputation in their mark 'AirTel' thus the said brand should be either treated as super brand or a universal brand. They have further contended that by virtue of such a status of super brand they are entitled to protection vice-a-versa all kind of goods using such a word mark 'AirTel'. Plaintiffs have stated in the plaint that sometime in or about 2002 the plaintiffs commissioned the services of M/s. Ray and Keshvan Designer for the purpose of creating an artistic work with the label mark using the word 'AirTel'. It is their further case that Ms. Sujata Keshavan and Ms. Meeta Malhotra, the

Creative Controller employed by the creative agency were entrusted with the work of creating the artistic work and they have created the design and artistic work for the plaintiff with the use of the word ‘AirTel’. The said artistic work is set out at Exhibit-D to the plaint which indicates use of the word in a particular manner with a different colour combination of Red, White and Black. According to the plaintiffs they also started using the said artistic work on the carton and/or on the label on the packs for the purpose of distributing, marketing and selling their services since 2002. They have contended that they have sold their products and services with the said label on a extensive basis all over India and thus they are the sole proprietor of the said artistic design. Plaintiffs have also filed an application for the registration of their word mark ‘AirTel’ under the Trade and Merchandise Marks Act, 1958. The application is also filed for label mark and the same is also pending since 2002. Application for label mark with artistic work has been filed under the Copy Rights Act.

The plaintiffs have stated in the plaint that they are using the said mark ‘AirTel’ and the artistic work covered by the said label all over the country extensively and in support of the same the plaintiff have relied upon the sales figures and the figures of advertisement expenses indicating extensive sale of their products and the huge amount of money spent towards the advertisement. Therefore the plaintiffs company claim to be known by the word ‘AirTel’ in the market and thus plaintiffs are require to protect their business and goodwill in the market. Plaintiffs claims to have as of today 30.71 million subscribers in almost 16 states and a customer base of 24% of the cellular subscribers in India i.e. the biggest and largest market in the cellular phone services. Plaintiffs also claims to be engaged in prepaid and post-paid mobile cards for the purpose of mobile sales services and recently the plaintiffs have also entered into land-line telephone services. Plaintiffs have also claimed to have diversified their business and services such as in the field of V-SAT services, submarine cable

projects manufacturing of telecommunication equipment and health care.

4. It is the case of the plaintiffs that sometime in or about 2.9.2003 the plaintiffs came to know that the defendants are using the said mark 'AirTel' which is identical and deceptively similar to the mark of the plaintiff. Apart from using the said word mark 'AirTel' the defendants are also using the label alongwith words 'AirTel' with the identical colour scheme and almost similar writing on their products which is alcoholic beverages. Thus the plaintiffs contend that the defendants by dishonestly copying the label as well as the word mark and are trying to pass off their business as that of the business of the plaintiff and thus the plaintiffs goodwill, business and reputation has been seriously suffered and affected. It is on the aforesaid contention the plaintiffs have filed the present suit for passing off action in the trade mark as well as for protection of copy right in their artistic work and passing off action of their

proprietary artistic work.

5. Thus essentially the plaintiff are pressing the prayer clause (b) in the nature of passing off action. The prayer (a) of the motion is not pressed since the plaintiffs are neither having their mark registered under the provisions of the Trade and Merchandise Marks Act nor their mark is registered under the Copy Right Act.

6. In response to the claim of the plaintiffs the defendant no.1 has filed an affidavit in reply. In the affidavit of the defendant no.1 it is contended that the goods which are in the market of the plaintiff are distinctively different to the goods of the defendant herein therefore the user of a similar mark or similar get up in respect of different products altogether cannot result in any confusion among the consumers in the market. It has been further contended that the goods are polls apart i.e. the plaintiff goods/business being telecommunication services and the goods of the defendant being selling of

liquor and alcohol beverages, the question of any likelihood of any confusion or actual confusion would not arise between the goods of the plaintiffs and the goods of the defendant herein in the minds of consumers. It has been further contented that there are various other parties who are also using the word ‘AirTel’ in relation to various products and thus the plaintiff has no exclusive right to use the said mark ‘AirTel’. In para-8 of the affidavit in reply an explanation has been furnished by the defendants for using the mark ‘AirTel’ which reads as under :

> ". The said word "AirTel" was adopted by the owner of the said mark to suggest that the person who will use the said products, will enjoy it so well that he will feel like flying in air talking to the people."

7. It has been further contended by the defendant no.1 in their reply that the defendant no.2 Pooja Keshavan is the proprietor of the said mark and it is she who has conceived the said mark ‘AirTel’. However it is not disputed that the word mark is identical as well as the nature of fonts used by the defendants are also identical to

that of the plaintiffs mark. It has been contended that it is the defendant no.2 who is the proprietor of the said mark and she has assigned the same to the defendant no.1 for the user thereof. It has been contended that the defendant no.2 has submitted an application for registration of the said mark ‘AirTel’ and thus the use of the mark by the defendant is bonafide and cannot be considered as dishonest user of the mark. It has been further contended that in view of the fact that the goods being totally different the question of passing off of the defendants business as that of the plaintiff cannot and does not arise. No consumer would believe that the goods of the alcoholic beverages are manufactured by the plaintiff who are solely and essentially in the business of telecommunication services. It has been thus contended in reply that the defendant is not entitled to relief of any nature whatsoever.

8. Learned counsel Mr. Tulzapurkar for the plaintiffs has contended that since 1994 the plaintiffs are using the word mark ‘AirTel’ and

that the label is also created by them in 2002 and therefore they are the owners of a design and entitled to the copy rights in the said label mark as well in the word mark ‘AirTel’. He has further contended that by virtue of the sale and advertisement expenses incurred by the plaintiffs and the extensive use of the word mark the plaintiffs word mark has acquired a status of super brand and/or universal brand and thus the plaintiff is entitled to protect their brand as against the world at large inrespect of all the goods and business. It is contended that the explanation inrespect of adoption of mark by the defendant of the word mark ‘AirTel’ is totally dishonest, bogus and without any substance. Apart from the same it has also been contended that the get up of the mark which has been copied by the defendant alongwith the word mark ‘AirTel, and the label is almost similar and identical and it is direct infringement of the plaintiffs artistic work and word mark ‘AirTel’. It has been further contended that though it is claimed that the defendant no.2 is the owner of the mark but

neither the defendant no.2 has filed any affidavit in reply opposing the present notice of Motion nor any case has been made out of the user of the mark. In so far as the user of the mark of the defendant no.1 is concerned it is only from June 2003 on their own showing and thus it is evident that the plaintiffs are prior user of the mark 'AirTel' with the artistic label mark which has been created by the plaintiffs and their design and labels have been first published in 2002. It has been contended that in so far as the question of infringement of copy right in the label is concerned the contention that the goods are different is totally an irrelevant factor and it is not necessary that the goods need to be identical or similar or from the common field of activities or an allied or cognet products when a question of passing of any artisitic work under the Copy Right Act arises. It has been contended that a copy right is in label, and in design and get up of the said label and thus needs to be protected irrespective of any relation or not to any product or goods. In support of the aforesaid

contention learned counsel for the plaintiffs have relied upon the provisions of S.14, 51 and 55 of the Copy Right Act. The said provisions are reproduced hereunder:

> "**14. MEANING OF COPYRIGHT : For** the purposes of this Act, "copyright means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:-
>
> (a) in the case of a literary, dramatic or musical work, not being a computer programme,-
>
> (i) to reproduce the work in any material from including the storing of it in any medium by electronic means ;
>
> (ii) to issue copies of the work to the public not being copies already in circulation.
>
> (iii) to perform the work in public, or communication it to the public;
>
> (iv) to make any cinematograph film or sound recording inrespect of the work;
>
> (v) to make any translation of the work;
>
> (vi) to make any adaptation of the work
>
> (vii) to do, in relation to a translation or an adaptation of the work any of the acts specified in relation to

the work in sub-clauses (i) to (vi)

(b) in the case of a computer programme,-

(i) to do any of the acts specified in clause (a);

(ii) to sell or give on hire, or offer for sale or hire, any copy of the computer programme, regardless of whether such copy has been sold or given on hire on earlier occasions;

(c) in the case of an artistic work-

(i) to reproduce the work in any material form including depiction in three dimensions of a two dimensional work or in two dimensional of a three dimensional work;

(ii) to communicate the work to the public;

(iii) to issue copies of the work to the public not being copies already in circulation;

(iv) to include the work in any cinematograph film;

(v) to make any adaptation of the work;

(vi) to do in relation to an adaptation of the work any of the acts specified in relation to the work in sub-clause (i) to (iv).

(d) in the case of a cinematograph film,-

(i) to make a copy of the film

including a photograph of any image forming part thereof;

(ii) to sell or give on hire, or offer for sale or hire, any copy of the film regardless of whether such copy has been sold or given on hire on earlier occasions;

(iii) to communicate the film to the public;

(e) in the case of a sound recording,-

(i) to make any other sound recording embodying it :

(ii) to sell or given on hire, or offer for sale or hire, any copy of the sound recording regardless of whether such copy has been sold or given on hire on earlier occasions;

(iii) to communicate the sound recording to the public.

Explanation- For the purposes of this section, a copy which has been sold once shall be deemed to be a copy already in circulation.]

"51. WHEN COPYRIGHT INFRINGED- Copyright in a work shall be deemed to be infringed-

(a) when any person, without a licence granted by the owner of the Copyright or the registrar of Copyrights under this Act or in contravention of the conditions of a licence so granted or any condition imposed by a competent authority under this Act-

(i) does anything, the exclusive right

to do which is by this Act conferred upon the owner of the copyright, or

(ii- permits for profit, any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, unless he was not aware and had no reasonable ground for believing that such communication to the public would be an infringement of copyright; or]

(b) when any person-

(i) makes for sale or hire, or sells or lets for hire, or by way of traded displays or offers for sale or hire, or

(ii) distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright, or

(iii) by way of trade exhibits in public, or

(iv) imports into India, any infringing copies of the work :

[Provided that nothing in sub-clause (iv) shall apply to the import of one copy of any work for the private and domestic use of the importer.]

Explanation-for the purposes of this section, the reproduction of a literary, dramatic, musical or artistic work in the form of a cinematograph film shall be deemed to be an "infringing copy".

"55. CIVIL REMEDIES FOR INFRINGEMENT OF COPYRIGHT- (1) Where copyright in any work has been infringed, the owner of the copyright shall, except as otherwise

> provided by this Act, be entitled to all such remedies by way of injunction, damages, accounts and otherwise as are or may be conferred by law for the infringement of a right :
>
> Provided that if the defendant proves that at the date of the infringement he was not aware and had no reasonable ground for believing that copyright subsisted in the work, the plaintiff shall not be entitled to any remedy other than an injunction inrespect of the infringement and a decree for the whole part of the profits made by the defendant by the sale of the infringing copies as the court may in the circumstances deem reasonable.
>
> (2) Where in the case of a literary, dramatic, musical or artistic work, a name purporting to be that of the author or the publisher, as the case may be, appears on copies of the work as published, or in the case of an artistic work, appeared on the work when it was made the person whose name so appears or appeared shall in any proceeding inrespect of infringement of copyright in such work, be presumed unless the contrary is provided, to be the author or the publisher of the work, as the case may be.
>
> (3) The costs of all parties in any proceedings inrespect of the infringement of copyright, shall be in the discretion of the court.

9. Learned counsel has also contended that even for protection of the trade mark ‘AirTel’ it is not necessary that the goods must be similar or

identical or from the common field of activities He has further contended that once a brand has achieved a status of super brand or of universal brand then the said brand needs to be protected against all kinds of goods, products, services and business. It is thus contended that it is not necessary that the goods should be similar or allied products. In support of his aforesaid contention he has relied upon the judgment of this court in the case of **Kirloskar Diesel Recon P.Ltd and anr. vs. Kirloskar Proprietary Ltd and Ors. reported in AIR 1996 Bom.149** of which para 12 to 15 and 18 reads as under :

> "13. The expression 'common filed of activity' was coined by Wynne_parry J, in McCulloch v. Levis A, May (Product Distributors Ltd) popularly known as 'Uncle Maccase reported in 65 RPC 58 in which he held that its presence or absence was conclusive in determining whether or not there was passing off. However, the requirement that a 'common filed of activity' is conclusive in determining whether there can be passing off has been extensively criticised by Manning J. in the case of Henderson v. Radio Corp. Pty reported in (1969) RPC 218 holding that it would be unsafe to adopt the view expressed in McCulloch v. Mary that what has been called a common filed of activity

must be established in every case to entitle the plaintiff to succeed. He further held that it is going too far to say that the absence of this so-called common field of activity necessarily bars a plaintiff from relief. With the passage of time, law on requirement of common field of activity in a passing off action has radically changed. There is no requirement for a common field of activity to found a claim in passing off. In Marage Studies v. Counter Feat Clothing Co.Ltd reported In (1991) FSR 145, Browne Wilkison V-C said that the so-called requirement of the law that there should be a common field of activity is discredited. The real question in each case whether there is as a result of misrepresentation a real likelihood of confusion or deception of the public and consequent damage to the plaintiff. The focus is shifted from the external objective test of making comparison of activities of parties to the state confused. With the passage of time and reputation acquired, the trade mark 'Kiroloskar' has acquired the secondary meaning and has become almost a household word. The judgments relied upon by Mr. Kane pertain to the cases of one type of business and not where variety of businesses have been carried by the plaintiff and defendant as in the instant case. The business activities of the Respondents vary from pin to piano as borne out from the object clauses of the Memorandums of Association of the Respondents. The appellants have still to commence their business activities but as mentioned in the Memorandums of Association of 1st appellant in each appeal, some of the object clauses therein over lap with the activities of Respondents and more particularly of Respondents nos.6 and 7".

> 15. The law of passing off protects goodwill against its erasing or mark. the exclusive reputation of trading name is protected and prevented from being debased. The Delhi High Court in the case of Dainler Benz Aktregesellschaft v. Hybo Hindustan (AIR 1994 Delhi 239) (supra) relied on by Mr. Tulzapurkar, has correctly held that the trade mark law is not intended to protect a person who deliberately sets out to take the benefit of somebody else reputation withe reference to goods, especially so when the reputation extends world wide. It is further held that there are names and marks which have become household word 'Benz' as name of a car would be known to every family that has ever used a quality car. The name 'Benz' as applied to a car, has a unique place in the world. Thus the boxes in which the defendant sells undergarments for men, the representation therein is of man with his legs separated and hands joined together above his shoulder, all within a circle indicate, he strong suggestion of a link between the tree pointed star of 'Mercedes Benz' car and the undergarments sold by the defendant. This cannot be considered to be a 'honest concurrent user' by the defendant of the said symbol and hence the defendant could be restrained from using the word 'benz' with reference to any underwear which is manufactured by the defendant."

10. Thereafter he has relied upon the judgment of the Division Bench of this court in the case of

Aktiebolaget Volvo vs. Volvo Steels Limited in Appeal No. 570 of 1995 in Notice of Motion no. 950 of 1995 decided on 16-10.1997 particularly the following para :

> "33. In the matter of Daimler Benz Aktiegesellschaft and anr. vs. Hybo Hindustan reported in AIR 1994 Delhi 239, the plaintiffs Benz sought injunction against the defendants using the name "Benz" for the production like undergarments. It was held as under :
>
> > "There are names and marks which have become household words. "Benz" as name of a car would be known to every family that has ever used a quality car. The name " Benz" as applied to a car, has a unique place in the world. there is hardly one who is conscious of existence of the car/automobiles who would not recognize the name "Benz" used in connection with cars. Thus the boxes in which the defendant sells its undergarments for men, and the representation thereof is of a man with his legs separated and hands joined together above his shoulder all within a circle indicate the strong suggestion of the link between the three pointed' star of "Mercedes Benz" car and the undergarments sold by the defendant. This cannot be considered to be a "honest concurrent user" by the defendant of the above said symbol. therefore the defendant could be

> restrained from using the word "Benz" with reference to any underwear which is manufactured by them and injunction could be issued restraining the defendants to cease and desist from carrying on trade in undergarments in the name of "Benz" and "Three Pointed Human Being in a Ring" forthwith. The trade mark law is not intended to protect a person who deliberately set out to take the benefit of somebody else's reputation with reference to goods especially so when the reputation extends world wide. By no stretch of imagination can be said that use for any-length of time of he name "Benz" should be not objected to"

34. In the matter of Alfred Dushill Ltd and anr. vs. Sunoptice S.A. and anr. reported in 1979 FSR 337 the plaintiffs A.D. Ltd had for many years carried on business in the United kingdom and, through various subsidiary and associated companies throughout the world in the sale of tobacco products, smokers requisites and wide range of luxury goods. Their entire business had been conducted under the name and trade mark "Dunhill": and the evidence showed that they were widely known as "Dunhill of London". They had not sold sunglasses or spectacle frames in the United Kingdom, though their American subsidiary had made small sales of sunglasses in the USA. They were however involved in negotiation with a view to entering that market. The first defendant, S.S.A. a Swiss company began to advertise and sell sunglasses and spectacle frames under the trade mark "D Christopher Dunhill-London", pursuant to an agreement with the second defendant.t, C.D. who was the great grandson of the

founder and son of the present chairman of A.D. Ltd. By that agreement C.D. in consideration of large royalties, licensed S.S.A. to use his name in that manner and undertook to act as consultant. In relation to the range of sun-glasses and spectacle framed to be sold by S.S.A.. it was admitted that he had no particular expertise in that field but the defendants argued that he was entitled to use his own name to further his own commercial aims and ambitions. The plaintiffs moved for a world-wide interlocutory injunction but at the hearing restricted the relief sought to certain specified countries. Whitford J held that the evidence of the plaintiffs reputation was "meagre" but was not prepared to hold that the plaintiffs had not reasonable prospect of success in their claim for a permanent injunction at the trial. He refused interlocutory relief on the ground that the plaintiffs should not suffer significant damage pending the trial and the grant of an injunction would be a serious impediment to the defendants operation. He further started that even if an injunction had been granted he would not have granted it in respect of any countries other than the United Kingdom. The plaintiffs appealed to the court of Appeal and argued that this being a plain case of a deliberate attempt by the defendants to "cash in" on the plaintiffs reputation and there being in the evidence adduced no credible dispute on the primary facts, the court was entitled within the principles laid down by the House of Lords in American Cyanamid v/ Ethicon to consider the merits of the plaintiffs case and should not hesitate to stop by injunction a blatant fraud. They further argued that damages would be an inadequate remedy to the plaintiffs if any injunction were refused. Upon further evidence which was admitted in the court of appeal the plaintiffs

argued the harm which an injunction would cause to the defendants would be much less than the harm which the plaintiffs should suffer if the defendants activities were allowed to continue pending the trial. allowing the appeal it was held as under :

(1) That there were in the evidence substantial disputes on the facts, in particular as to allegation of fraud and the extend of the plaintiffs reputation and in the circumstances this was not a case which could be decided by considering the respective merits of the parties' cases even if (which the court did not decide) it would be proper to do so in a case where there was no substantial dispute as to the facts.

(2) The damages would be an inadequate remedy to the plaintiffs if they were ultimately to suceed and there was doubt as to the ability of the defendants to pay the damages which might be awarded in that event, whereas the damage which would be caused to the defendants if any interlocutory injunction were granted was shown by the documents produced by the hearing of the appeal to be considerably less then they had asserted in their evidence and less than the judge had feared.

(3) That the injunction should be restricted to the United Kingdom and Switzerland, that being the only country inrepsect of which there was any evidence of foreign law".

The appeal court also observed on page 362 that"with very great respect to the learned judge the judgment doe snot seem to deal with the point that it was alleged damage to the overall Dunhill reputation which was in issue and not damage to particular classes of goods which Dunhill

were presently involved in selling".

11. He has further relied upon the aforesaid judgment to contend that it is necessary to determine that the explanation given by the defendant to use the same mark is honest or not is a very relevant factor for the purpose of grant of injunction and in respect of the same he has relied upon para 61 of the said judgment which reads as under :

> "61. Taking into consideration various cases cited by both sides we are of the opinion that the crux of the passing off action lies in actual possible or probable deception. the plaintiffs necessarily has to establish reputation and goodwill. In quia timet action he must also show the probability of the plaintiffs suffering damage either in trade or to his goodwill and reputation. Deception may be of several kinds i.e. that the public may think that the goods manufactured by the defendants are in fact manufactured by the plaintiffs or that there is some trade connection or association of the defendants with the plaintiffs. It is also clear that the trans border reputation has been recognised by Indian courts and as a matter of law it is not necessary to prove the actual sale, if by other material presence of the plaintiffs in India and goodwill and reputation in

> India is demonstrated. It is also clear to us that as a matter of law the "common field of activity" is not required to be established. However, as the crux of passing off action lies in possible deception, the existence of common field of activity is always a relevant consideration. If there is a common filed of activity, possible of deception is very high and if there is no common field of activity possibility may be less, but it cannot be laid down as a rule of laws that there can be no possibility at all. Thirdly and more importantly, all these issues ultimately will depend on the facts and circumstances and the material on record of each particular case, as to whether the plaintiff has established the goodwill or reputation, whether the plaintiff has established the trans-border reputation, whether the defendant has caused misrepresentation innocently or deliberately and whether the plaintiff has suffered damage or is likely to suffer damage in quia timet action will be questions of fact to be determined by the court. It i is also clear that if it is shown that the defendant intended to deceive, the burden would be much lighter on the part of the plaintiff. The existence of unexpected and unexplained similarities between the goods of the defendant and the plaintiff or lack of explanation or false explanation for adoption of name by the defendant, may be extremely relevant."

12. He has thereafter relied upon the judgment of the Allahabad High Court in the case of **Bata India Limited vs. M/s. Pyare Lal and Co. Meerut City**

and Ors. reported in AIR 1980 All 242 and judgment of the division bench of this court in the case of **Kamal Trading Co.,Bombay and Ors vs. Gillette U.K. Ltd, Middle Sex, England, reported in 1988-PTC 1** particularly para 13 of the said judgment which reads as under :

> "13. Finally Mr. Desai submitted that while admitting this appeal on December 12, 1986, the Division Bench granted interim relief pending the hearing of the appeal by putting certain conditions before which the defendants could use the trade mark "7 O" CLOCK'. It is the claim of Mr. Desai that the defendants have carried out the conditions set out by the Division Bench and, therefore there is no occasion now to grant interim injunction. The conditions put by the Division Bench were that number will not be written within the circle of letter 'O' that the letter 'O' in the mark would be plain on the device of a or any other mark to convey any connection to any foreign country will not be used that letter 'R" within a circle to represent that the mark is registered trade mark will not be used; that the appellants would put the words " Made in India" below the words "Tooth Brush" and also the words " Manufactured by Kamal Trading Company" on the plastic pouch, and that the manufacture or sale of tooth brushes will not exceed 20,000. We fail to appreciate how grant of this relief pending the appeal can create any right in the defendants to insist that the same order be passed at the hearing of the appeal;. We have hard Mr. Desai very

extensively and we find that not only there in no merit in the appeal but the entire conduct of the defendants is totally dishonest and fraudulent in using the mark "7 O'CLOCK". To begin with, the defendants are unable to explain how the mark was assigned by them. The mere perusal of the tooth brush and the plastic pouch in which it was sold clearly reveals the dishonest conduct of the defendant. The mark issued on the tooth brush and the plastic pouch is also not identical. The plastic pouch mentions the word 'R' in a circle to suggest that the mark used by the defendants is a registered mark. In addition, a picture of tower possibly Fifet Tower is printed on the pouch to suggest that the goods are manufactured in Paris. The defendants also used the words as Hollywood-London-Paris" to suggest that the goods are of the foreign made. This conduct on the part of the defendants clearly indicate that the anxiety was to trade upon the reputation of the mark "7'O CLOCK" and not to leave any chance for customer to detect the mis-use of the mark further effort was made to give an impression that the mark is registered mark and the goods are manufactured in foreign country. It is hardly required to be stated that when the defendants are guilty of total dishonesty then it is futile to claim that when the aggrieved party goes to the court, the defendants should be permitted to use the mark by making some alteration,. When confronted with the conduct of the defendants, the only excuse Mr. Desalt can think of is that the defendants are illiterate and the commencement of the marks was without taking legal advice. In our judgment, the conduct reveals the mind of the defendants and the conduct by no stretch of imagination can be said to be either bonafide or innocent. We also cannot overlook the fact that' the defendants did

> not bother to produce any invoice in support of the claim that the goods were sold from 1982 onwards and the sale figures annexed as Ex.1 to the affidavit in reply were correct figures. We enquired from Mr.Desai as to how the amounts were spent on the advertisement and the answer was that the advertisement boards were put up in shops where the tooth brushes are sold. No affidavit of any trader or any distributor is filed in support of the claim nor did the affidavit of partner sets out the names of any distributors to whom the advertisement material was handed over. In these circumstances, were are unable to accept the claim made by the defendants by setting out certain figures in Ex.' to the affidavit on the facts and circumstances of the case, the learned single judge was perfectly right in granting relief to the plaintiffs and there is no infirmity whatsoever in the impugned order".

13. He has relied upon the judgment of the Madras High Court in the case of **Intel Corporation vs. S. Ramanan Director and anr. reported in 2002(25) PTC 457(Mad)** and particularly para 17 which reads as under :

> "17. It is therefore clear from the aforesaid decisions as well as the discussion that the applicants trade name is widely known in the business circle since 1968, but however so far as India is

concerned, the branch office was opened as early as 1988 at Bangalore and in view of the wide publicity made in various places in different modes, it is certain that the business people at large would have got knowledge and information about this trade name. simply because the name of the respondents was registered earlier in point of time, it cannot be said that they have got prima facie case. Considering the overwhelming documentary evidence filed on the side of the applicant it is clear that the applicants trade name is popular throughout the world. I am unable to agree with the contention of the learned counsel for the respondents that the word INTEL is only an abbreviation of International. The trade name INTEL has been coined by the applicant and they have widely used the same for a very long time. No doubt, the trade name of the respondents is INTELTOOLS; but by this, it cannot be said that they are entitled to use the same. The products manufactured by the applicant company are marketed under the trade name INTEL and if the same name is used by the respondents also there is very possibility for deception and confusion in the minds of the public . Apart from that, although the products manufactured by the respondents are a different one from the products manufactured by the applicant, the trade public will be misled and the product of the respondents would be misunderstood as the product of the applicant. The applicant company is a big one when compared to the company of the respondents. It is not difficult for the respondents company to change the name and market their products since it is not a recognised once in the business circle and by this, no prejudice or loss would be occasioned to the respondents. The applicant company has got prima facie case and the balance of convenience is also in

> their favour;. If the order of interim injunction is not granted in favour of the applicant, they would be put to much loss and hardship and as such, the interim injunction already granted has to be made absolute."

14. He has thereafter relied upon the judgment of the Delhi High Court in the case of **Daimler Benz Aktiegesellschaft and anr. vs. Hybo Hindustan reported in AIR 1994 Delhi 239** particularly para 18 of the said judgment.

> "18. In the instant case, "Benz" is a name given to a very high priced and extremely well engineered product. In my view, the defendant cannot dilute, that by user of the name "Benz" with respect to a product like underwears."

Thereafter he has relied upon the judgment of **Corn Products Refining Co. vs. Shangrila Food Products reported in AIR 1960 SC 142** particularly para 13 thereof which reads as under :

> "13. The second point on which the learned appellate Judges based themselves

in arriving at the conclusion that there was no reasonable apprehension of confusion or deception was, as we have earlier stated, that there were various trade marks with a prefix or suffix ‘Gluco’ or ‘Vita’ and that made it impossible to say that the common features ‘Glu’ and ‘Vita’ were only associated with the appellant’s products. This view was founded on a passage which the learned appellate Judges quoted from Kerly on Trade marks 7th Edn.,p.624. That passage may be summarised thus : Where there are a series of marks registered or unregistered, having a common feature or a common syllable, if the marks in the series are owned by different persons, this tends to assist the application for a mark containing the common feature. This statement of the law in Kerly’s book is based on In re: an application by Beck, Koller and Co. (England)Ltd (1947) 64 T P.C. 76. It is clear however from that case, as we shall presently show, that before the applicant can seek to derive assistance for the success of his application from the presence of a number of marks having one or more common features which occur in his mark also, he has to prove that these marks had a acquired a reputation by user in the market. We will now read a portion of the judgment at pp.82 and 83 in Beck, Koller and Co.’s case fro which what we have sated earlier appears:

> "I am disposed to agree with Mr. Burrell’s submission that the ‘series’ objections is primarily founded upon user, because the inference which the Registrar is asked to draw is that traders and the public have gained such a knowledge of the common element or characteristic of the "series" that when the y meet another make

having the same characteristic they will immediately associate the later mark with the "series" of marks with which they already similar. But I do not think that this statement necessarily implies that the whole issue must be determined solely under the provisions of S.11 as I will now endeavour to explain.

When an application for registration is before the Registrar it frequently happens that the for conflicting marks reveals several marks having some characteristic feature in common with the mark of the application, which marks may stand on the Registrar in the name of one proprietor only or in the name of of several different proprietors. At this stage, when the matter is one between the applicant and the Registrar, the latter generally has before him no evidence as to whether the registered marks are in actual use or not, but in forming an opinion under s.12 as to whether or not confusion or deception is likely to arise, he is bound, I think, in the absence of evidence to presume that, prima facie, some atleast of the registration have been effected bonafide by persons who at the date of their respective applications were using or proposed in the near future to use their marks. If, therefore, all the marks were owned by one proprietor, the Registrar would presume that the latter was using a "series" of marks and judge the conflict between the applicants mark and each of the proprietors

marks with this consideration in mind. Of course, if the registrations merely consisted of one and the same word registered separately inrespect of several articles to be found in agile class of the Trade Marks Schedules, the Registrar would in general regard all these registrations as but the equivalent of a single registration covering all the items, for they would not constitute a "series" as now under discussion. On the other hand, if the registered marks found were owned by several different proprietors, this would b a circumstance which might considerably assist the applicant, who would be in a position to submit that the common characteristic was one well recognised in marks in use in the particular trade. In short, when the Registrar comes to compare the applicant’s mark with the registered mark, using the principles laid down in the "Pianotist" case (....) the presence of marks on the Registrar other than the one with which the comparison is being made is regarded as one of the surrounding circumstances which he is required to take into account.

But when the same question comes before the Registrar in opposition proceedings, it appears to me that he is no longer in a position to make any presumption as regards the surrounding circumstances, btu that before he can draw the necessary inference based upon the user of other marks either in the

> applicant's or the opponent's favour, any such user must be established by evidence where the Registrar refused to draw the necessary inference in favour of the applicants in the proceedings. We have no reason to think that keryl in stating the law on the subject intended to depart from the principle stated in the passage that we have just now read from Beck Koller and Co.'s Case.

He has thereafter relied upon the judgment of the Division Bench in the case of **The Andhra Perfumery Works Joint Family Concerns vs. Karupakula Suryanarayaniah and Ors reported in AIR 1969 Madras 126.** He has thereafter relied upon the judgment of the Delhi High Court in the case of **Honda Motors Co. Ltd vs. Charanjit Singh and Ors. reported in 2003(26) PTC 1 (Del).**

15. It has been contended by relying upon the aforesaid judgments that the plaintiff is entitled to the protection of the word mark 'AirTel' irrespective whether the goods are cognet or allied products or similar products or complimentary products or not. It has been

further contended that a principle of common field of activity is no more a valid principles and a person acquiring a super-brand status in trade mark is entitled to protect their business and brand from being used by other persons so as to pass off the defendants business as that of the plaintiff herein.

16. It has been alternatively submitted that even if this court is of the view that goods being different and thus the plaintiff is not entitled to the said protection still by virtue of the provisions of the Copy Right Act the plaintiff is entitled to the protection of their getup and label with the word used ‘AirTel’ thereon and therefore this court should grant an interim order in terms of prayer clause (b) of the said Notice of Motion.

17. On the other hand learned counsel for the defendants have contended that there can be no dispute that the goods which are sold by the defendant is nowhere concerned or connected or

even close to the goods, product, services or business of the plaintiffs herein. It has been submitted by the defendants that the channel of sale of their products and the class of consumers are different and distinct and thus the question of any confusion in the market as between the plaintiffs goods and the defendants goods can never arise. It has been further submitted that the plaintiff has not produced any evidence to show that there is infact any confusion in the market between the goods belonging to the plaintiffs and that belonging to the defendants in the minds of the consumers so as to entitle the plaintiffs to obtain any interim injunction inrespect of their goods and/or business. Insupport of their aforesaid contention the learned counsel has relied upon the judgment of the learned single judge of this court in the case of **Raymond Limited vs. Mohammed Sakil Proprietor of M/s. Raymonds Luggage passed dated 6.5.2004 in Notice of Motiion no. 934 of 2004 in Suit No. 899 of 2004.** He has in particular relied upon the observation of the learned Single Judge which

reads as under :

> "13. Whether all such entities can institute proceedings claiming restraint orders on users of marks identical to them even if there is not similarity of goods/products, is a question which will have to be decided. I am merely opening a debate because this court is confronted with such issues almost every day. Admittedly, the Trademark Act, 1999 cannot be considered to confer a monopoly upon anybody. similarly, it's provisions will have to be considered consistent with the constitutional mandate enshrined by Articles 14, 19(1) (g) and 32 R/W Directive Principles of State Policy. The Preamble of our written constitution cannot be lost sight of while interpreting provisions in such statutes. Therefore, to my mind, the time has come where it is necessary to lay down broad principles in considering the applications for interim injunction. Whether it is possible to consider and hold that conduct of the plaintiff in approaching the Court is wholly irrelevant and the Court is obliged to go into merits even prima facie because of sanctity attached to a Trademark in public interest, is also a matter of some concern and requires elucidation. The above preface is necessary because initially I thought that there should be a debate and discussion in this case itself. However, I am of the view that above-mentioned aspects can be gone into and decided in an appropriate case where materials are produced to indicate that there is total dis-similarity and therefore, the question of applicability of the definition "Deceptively Similar", "False Trade Description" and "Well Known

> Trademark" are not attracted. Additionally, when there is total silence for years together after adoption till application for interim injunction is made after a long passage of time on adoption. This adjudication would become necessary if competitions not to be stifled and monopolies are not to be encouraged. In this context reference can usefully be made to a decision reported in AIR 1996 SC.

18. He has thereafter relied upon the judgment of another learned single judge in the case of **Soni Kabushiki Kaisha vs. Shamrao Maskar and Ors. reported in AIR 1985 Bom.327** particularly para 5 and 6 of the judgment which reads as under :

> "5. Section 11(a) of the Act provides that a mark, the use of which would be likely to deceive or cause confusion, shall not be registered as a trade mark. The contention urged on behalf of the petitioners is that the mark "SONY" has acquired world wide reputation and any product bearing the identical mark is likely to cause deception or confusion in the mind of the customers that the product has association with the manufacture of electronic goods of the Japanese Company. Now it cannot be again said the word "SONY" has acquired reputation inrespect of the electronic goods but the question of whether the use of the mark inrespect of Nail Polish is likely to deceive or

cause confusion amongst the customers is required to be determined by taking into consideration several circumstances. Section 11(a) requires the court to ascertain not only whether the mark has actually deceived or cause confusion but also whether it is likely to deceiver or cause confusion. the question as to whether any deception or confusion would caused has to be determined with reference to the facts of each case, and it is necessary to take into consideration the totality of the facts and the surrounding circumstances. The factors creating confusion would be the nature of the mark itself, the class of customers, the extent of the reputation, the trade channel, the trade, but the list is bit exhaustive and there will be several other circumstances which are required to bet taken into consideration in combination before recording a conclusion as to whether there is a likelihood of deception or confusion by use of the mark. Shri Tulzapurkar urged that the nature of the goods to be sold under the mark is an important factor and emphasis must be laid on the nature of the goods and the trade channel through which the goods would be sold, while examining the order of the Assistant Registrar in the present case. it is true that ordinarily the simultaneous use of identical or similar marks in relation to goods which are different will not lead to any deception or confusion, but circumstances may exist where the mark is so well known in the market that the use or the same in relation to different gods, may indicate to the public that they are coming from the same trade source. The trade channel through which goods will be sold is certainly a vital factor, but no single factor is conclusive on the point. On this principle it is now necessary to examine various facets of the case in hand.

6. It is not in dispute that the goods sold by the petitioners under the mark "SONY" are electronic goods like Television, Tape Recorders and Transistors, while the goods which the respondent desire to sell under the mark is nail polish, an item which is used by the women and artists. The electronic goods and nail polish are items poles apart, looking to the nature and purpose of their user. The nail polish is an item of cosmetics and the price being within the reach of common man, is sold on a large scale. The item is sold all over the town, in shops small and large. On the other hand, electronic goods manufactured by the petitioners are not easily available due to import restrictions. It is claimed that two-band transistors under the mark "SONY" are easily available in Bombay and even assuming it to be so, it cannot be overlooked that the trade channel for sale of the two items are entirely different. The electronic goods and nail polish are not sold under one roof and there will not be any confusion in the mind of the customer that both the items come from the petitioners house in Japan. There is also no common field of activity in course of trade of the two items, and the classes of customers who would purchase the two items are distinct and different. The petitioners had led no evidence whatsoever before the Assistant Registrar in the shape of affidavit of any dealer or consumer to indicate that the use of the mark by the respondents is likely to cause deception or confusion. Again the respondents are not using the mark "SONY" is written in a rectangular label appearing in the upper portion of the rectangle, letter ‘M’ appears in the small circle in the middle portion of the rectangle and a device of a flowers basket

> just above the rectangle. In my judgment in these circumstances the finding recorded by the Assistant Registrar that registration of mark sought by the respondents is not likely to cause confusion or deception in the minds of the customers in correct and deserves to be accepted."

19. He has thereafter relied upon the unreported judgment of the Supreme Court in the case of **Cadila Health Care Ltd vs. Cadila Pharmaceuticals reported in (2001) 5 SCC 73** particularly the guide-lines laid down by the apex court inrespect of passing off action as mentioned in para 35 of the said judgment. He has also relied upon an unreported judgment of this court in the case of **Four Seasons Hotels (Barbados) Ltd and anr. vs. Sukh Hotels Motels P.ltd decided on 29.10.2001** in Notice of Motion No. 3590 of 1999 in Suit no. 5898 of 1999. He has thereafter relied upon the judgment of the learned single judge of this court in the case of **Faber Castell Aktiengesellschaft and anr. vs M/s. Pikpen P.Ltd reported in 2003(4) Mh.L.J. 264** particularly he has relied upon para 14 of the judgment :

"14. Mr. Tulzapurkar, learned counsel for the defendants, however, submits that the plaintiffs are not entitled to claim any property in the trade mark. "TEXTLINER" because that word in purely descriptive of the nature and the character o the function to be performed by the goods in question viz. a device/instrument or mark or line the text or any written or printed matter. According to him, therefore the word "TEXTLINER" is purely descriptive of the nature and/or character and the function of the goods in question is not and cannot be a trade mark at all. The learned counsel refers to para 1(d) of the 2nd affidavit-in-rejoinder filed by the plaintiffs wherein the plaintiffs have denied that the mark is "wholly descriptive". there appears to be substances in this contention. There is no doubt that "TEXTLINE" is a result of combination TEXT and LINER. These two words taken independently are purely descriptive. I find that the result of this combination is also descriptive. It is descriptive of the function which the article is intended to perform. For instance, if the mark "running shoe" was used for shoes, it would clearly be descriptive of the goods even if the word "running shoes" were joint. I think the case is similar to the case of "SAFEMIX" reported in 1978 R.P.C. 397, wherein an application for registration was refused on the ground that the mark consisted of the words "SAFE" and "MIX" conjoined. Reliance has rightly placed on the decision in M/.s. Rochem separation Systems (1) P.ltd vs. Tas Engineering Co.P.ltd 2001(2) Mh.L.J. 146 = AIR 2001 Bombay 210 wherein the words "Disc Tube" were held to be descriptive by this Court. It is also true that as held by this Court

in 1999 P.T.C. 449 that where descriptive words are concerned, small differences are enough to distinguish and a mere similarity is not enough for passing off. the similarity must be accompanied by a misrepresentation. Applying the aforesaid decisions I am of the view that the plaintiffs have not, prima facie, established an exclusive right to the use of the word "TEXTLINER" which is descriptive in nature. It has not acquired any secondary significance taken by itself. It is important o recall the well known passage from Cellular Clothing Co.Ltd vs. Maxton and Murray which is quoted in the decision of the Kerala High Court in Bharthiya Coffee Workers Catering Service (P) Ltd vs. Indian Coffee Workers Co.op Soc.Ltd reported in 1999 PTC (19) 431 :

"But I confess I have always thought, and I still think that it should be made almost impossible for any one to obtain the exclusive right to the user of a word or terms which is in ordinary use in our language and which is descriptive only, and indeed, were it not for the decision in Reddaways case 1896 AC 1999 I should say this should be made altogether impossible. But where the plaintiffs, proof shows that the only representation by the defendants consists in the use of a term or terms which apply and correctly describe the goods offered for sale as in the present case it must be a condition for the plaintiffs success that they should prove that these terms no longer mean what they say - or no longer mean only what they say-but have acquired the secondary and further meaning that the particular goods are goods made by the plaintiffs, and, as I have already indicated, it is in my view difficult to conceive cases in which the facts will come up to this." Prima facie, it would

> follow that the word "TEXTLINER" is neither adapted to distinguish nor capable of distinguishing the goods of a particular manufacturer from those of another.

20. He has thereafter relied upon an unreported decision in the case of **Medley Pharmaceuticals Ltd vs. Khandelwal Laboratories Ltd in Notice of Motion no. 2808 of 2002 in Suit no. 3323 of 2002** decided by me on 27.9.2005 and he has particularly relied upon para 5 of the said judgment which reads as under :

> "5. However, the learned counsel for the plaintiffs has contended that the learned Single Judge of this Court has in the case of Pidilite Industries Ltd., vs. S.M. Associates & Ors., reported in 2004 (28) PTC 193 has taken the view that the mere fact that the said mark has been used by various other companies in the market is not sufficient to deny an injunction in favour of the plaintiff but the defendant must also establish that the parties who are using the similar mark in the market have huge market share and that their sale is of substantial amount. It is being contended that thus unless the defendant establish that the market share of third parties which are also using the said mark is of such a huge amount that the plaintiff can be disentitled to obtain the

injunction. The learned Single Judge in the aforesaid judgment has relied upon a judgment of the Apex Court in the case of Corn Products vs. Shangrila Food Products reported in AIR 1960 SC 142 and gave a finding that the defendant must establish a substantial evidence to show that the said goods are sold extensively in the market and the sale figures of such third parties are such that such a party has acquired reputation by user of the said goods in the market. It has been held by the learned Single Judge that the defendant must establish exclusive use in the market. Even at the interim proceedings according to the learned Single Judge it is not sufficient merely for the defendant to show prima facie that there is user of the mark by various parties in the market. He must produce a prima facie evidence to show substantial use and at the final hearing of the suit the level of the proof is higher and the defendant must prove a substantial use by such third parties. On the basis of the aforesaid judgement the plaintiffs have urged that the defendant has failed to show the substantial sale of the said various products which are sold in the market under mark "CEF" and thus even though products are sold in the market with similar mark as that of the plaintiff still the defendant should be injuncted from using the same mark. Apart from the fact that I do not subscribe to the view expressed by the learned Single Judge in the aforesaid judgment but I am refraining to go into the same in this matter. It is because in the present case on the facts in my opinion the defendant has been able to establish a substantial user of the said mark by various companies in the market. The defendants have produced before me in the form of sale figures of various companies by relying upon the survey conducted by ORG-MARG which are set

out at Exhibits 14, 15 and 16 of the affidavit in reply. A mere perusal of the said exhibits leaves no manner of doubt that the drugs almost with similar mark as that of the plaintiff and defendant both is in the market extensively and is being sold in market also with substantial sales figure. In that view of the matter I am of the opinion that the mark of the plaintiff does not have any exclusivity and is being frequently used not only by the defendant but by various other parties in the market in respect of pharmaceutical drugs. However, the learned counsel for the plaintiff has relied upon the judgment of the Apex Court in the case of Cadila Health care Ltd., vs. Cadila Pharmaceuticals Ltd., reported in AIR 2001 SC 1952. He has also relied upon the judgment of the Division Bench in which the Division Bench has interfered with the order of the learned Single Judge and has granted injunction. The learned counsel has relied upon para 27 of the said judgment and has contended that the confusion arising from similarly of marks among medicines are required to be taken into consideration and, therefore, the Court must grant an injunction. In the present case, no such case has been made out and, therefore the question of granting injunction on that basis does not arise. Thereafter the learned counsel has relied upon the unreported judgment of the Division Bench of this Court in Appeal No. 498 of 2002 in Notice of Motion No. 725 of 2002 in Suit No. 1305 of 2002 (Bal Pharma Limited vs. Wockhardt Limited & Anr. dated 12.6.2002 by A.P. Shah and Nishita Mhatre, JJ. and has contended that even if the pre-fix is common still the other words which are in common use in the said pre-fix specify the exclusivity of the said product in favour of the plaintiff herein. He has relied upon para 7 of the said judgment which reads as

under :-

"7. In order to decide whether the word "AZIWIN" is deceptively similar to the word "AZIWOK", each of the two words must, therefore, be taken as a whole word. Each of them consists of six letters, the first three letters "AZI" being common in both the words. The affidavit of the appellants indicate that various brands of Azithromycin tablets and syrup are marketed by different pharmaceutical companies using the common prefix AZI, which is derived from the generic name of drug and in fact the appellants have given a list of as many as 13 different names of the companies including the parties to the suit who are using the prefix AZI. It is thus apparent that the drug Azithromycin being the base of these products the word AZI has been commonly used in describing the product and no one can claim monopoly over the use of the said word. In fact any company producing Aazithromycin tablets would be justified in using the said word as prefix to its trade name. The word AZI being both descriptive and common to the trade the users of such product are not likely to be misguided or confused by the said word. Once it is held that the word "AZI" is common to the trade, then having regard to the un-common letters in these two words namely "work" and "win" which are totally dissimilar and also having regard to the fact that even phonetically the two words are totally dissimilar, it is difficult to hold that one will be mistaken or confused with the other. There is not even a remote chance of anyone being misguided by the two words. It is a common ground that Azithromycin can only be ordered by prescription from a certified medical practitioner and the public cannot be supplied with the same without such prescription as the said drug is

> "Scheduled H" drug. It is highly unlikely that doctors and pharmacists would get confused by the two marks."
>
> In the present case not only the pre-fix but even the suffix are commonly used with the word "CEF" by various companies and, therefore, also I do not find any substance in the present case.

21. By relying upon the aforesaid judgments learned counsel for the defendants have contended that the plaintiffs are not entitled to any interim injunction because the goods are totally different and not closely similar.

22. It has been thereafter contended by the learned counsel for the defendant that the word ‘Air’ and ‘Tel’ are both descriptive words and are found in English dictionary as two separate words and by merely joining them the said descriptive words do not acquire any exclusiveness or distinctiveness so as to entitle the plaintiff for any interim injunction in the said mark ‘AirTel’. It has been thereafter contended that the user of the mark and the adoption of the mark by the defendant is honest and therefore the plaintiff is

not entitled to any interim injunction. It is thus vehemently contended by the learned counsel for the defendant that the Notice of Motion should be dismissed and no interim relief should be granted to the plaintiffs herein.

23. I have considered the arguments advanced by both the learned counsels in depth. In so far as the first contention of the plaintiff is concerned that the plaintiff is entitled to injunction and passing off in respect of the goods belonging to the defendant which is admittedly not similar to that of the plaintiff. The plaintiffs are doing the business in the field of telecommunication and mobile service whereas the products which are sold by the defendant is whisky and not in any manner connected or in any way concerned with the business of the plaintiffs herein. The products which are sold by the plaintiffs and the products which are sold by the defendants are polls apart and cannot be described as cognet goods or goods from the common field of

activity nor can the same be described as allied products or complimentary to each other. The goods are totally different. However the learned counsel for the plaintiffs has contended that irrespective of the dissimilarity of the products of the plaintiffs and the defendants and irrespective of the fact that their products are not even close complimentary, cognate and ancilary goods still plaintiffs are entitled to claim the injunction of passing because the defendants are passing off his business as if the same belonging to the plaintiffs. He has further contended that the brand of the plaintiffs have acquired a super status and super brand and thus entitled to injunction of passing off inrespect of different goods. I have considered the aforesaid submissions and I am not inclined to accept the same. Firstly it is not in dispute that the business of the plaintiff has commenced under the brand name ‘AirTel’ sometime in or about 1994 and the label design is created only in 2002. Secondly it is not in dispute that the business of the plaintiff is totally different than the

business of the defendant herein. The principles which are required to be followed for the purpose of granting of injunction on the basis of passing off inrespect of totally dissimilar goods which are not event cognet or falling in the common field of activity is that it must be shown that infact the defendant by carrying on business in the said name is seeking not to pass off his goods as that of the plaintiffs but infact is seeking to pass off his business as that of the plaintiffs business. To accept such proposition of law it is very essential that the business of the plaintiffs must be such a nature that it is world wide and so big and so great that by mere use of the brand name or trade name it can be stated that the defendants are seeking to pass off his business as if it is the business of the plaintiff. It is also essential for upholding such proposition of law that the business of the plaintiff must be in large variety of products and in many fields so that it is likely to confuse with the business of the defendants. Mere acquisition of a popularity or reputation in one particular brand vice-a-versa

in relation to one particular business and not having any cross nations reputation does not entitle a person to claim an exclusive right to use a particular brand name and prevent them from using the said mark or brand name in relation to any goods. A principle in such cases is not of passing off goods but is a passing off of a business.

24. The well known author Kerly's has in his book Kerly's Law of Trade Marks and Trade Names, 14th Edition 2005 while enamiciating the aforesaid principle has stated as under :

> "There is no rule that the defendant must operate in the same field of activity as the claimant. However, this does not mean an examination of their respective fields of activity is irrelevant. The more remote the activities of the parties, the stronger the evidence needed to establish misrepresentation and the real likelihood of damage that are prerequisites of a right of action in passing off. Although this is a question of fact to be determined in the circumstances of the particular case, instances of decisions may be helpful and are given below."

25. In my opinion the court is empowered to grant injunction on the ground of passing off even if the defendants do not operate in the same field of activity but while doing so the court must see whether the plaintiffs are able to establish implacable reputation of such a huge nature that the business carried out by any person under the said trade name would tantamount to suggest that it is the business of the plaintiffs. In my opinion in the present case such principle has not been satisfied by the plaintiffs. The plaintiffs reputation undoubtedly is only inrespect of the business of telecommunication and it is not extended to any other business or products. The reputation of the business of the plaintiff is only in India. It has not travelled to other nations. Further more it is not possible to accept the contention of the plaintiff that a person buying a whisky, liquor would assume that it is the plaintiffs who are selling the whisky in the market in place of the defendants herein. Strong reliance placed by the learned counsel for the plaintiffs on the judgment of the Delhi High

court in the case of Mercedes Benz (supra) and in the case of Volvo(supra) are in my opinion do not apply to the facts of the present case. There can be no dispute that the brand Mercedes Benz is a well known reputed brand though in relation to motor vehicle. Same is the position in the case of Volvo for the buses. In the judgment of the Delhi High Court the court was of the view that while using the mark Mercedes and Benz in relation to undergarments manufactured by the defendant he infact sought to copy the said mark with the picture of logo and he had an intention to earn on the reputation of the well established Mercedes Benz brand. Insppourt of the aforesaid contention the Delhi High Court came to the conclusion that the emblem of the Mercedes Benz is also been copied by the defendant in that case while using the said brand name in relation to his product of undergarments. In the case of Volvo also the main consideration of the Division Bench to grant relief was that the Volvo was already well established brand and had acquired a super status brand. In the present case the plaintiffs have

undoubtedly acquired a reputation in their brand name ‘AirTel’ but to hold that the said reputation is of such a nature that it has acquired a super brand status or has acquired the international reputation so as to prevent any person from carrying on any business under the said name is in my opinion cannot sustain on the facts of the present case. Thus I do not accept the contention of the learned counsel for the plaintiff in relation to passing off of the business of the defendants as if the same belongs to the plaintiffs herein.

26. The other judgments which are cited by the the learned counsel for the plaintiffs particularly in the case of Bajaj Electricals, Kirloskar, Corn Products, Kamal Trading I am of the view that all these cases fall in a class where the goods were either cognet goods or from the common field of activity and thus not much relevant for the purpose of determination in the present case in so far as the claim of the plaintiff which is based not on passing off the

goods but on passing off of the business.

27. The defendant has thereafter contended that the word ‘Air’ and ‘Tel’ are the descriptive English language words and no person can claim any exclusive right on the user of the said words. It has been contended that the plain simple dictionary words cannot claim as the words of a brand name or a trade mark as if the same are exclusively innovated by the plaintiff herein. It is thus submitted the words ‘Air’ and ‘Tel’ being simple dictionary words this court should not grant any injunction inrespect of passing off as claimed by the plaintiff. In so far as the aforesaid contention is concerned I am not inclined to accept the same because not doubt it is true that the word ‘Air’ and ‘Tel’ are the English words and the plaintiffs have by user thereof in a particular combination of the word ‘Air’ and ‘Tel’ jointly has created an innovative one word ‘AirTel’ which is not a common English word and thus acquired an exclusive reputation inrespect of the said brand and the said trade

name in their favour.

28. Learned counsel for the defendant has thereafter contended that the plaintiff has not been able to show actual confusion in the market between the goods belonging to the plaintiffs namely telecommunication and tele services and on the other hand the goods of the defendants namely whisky and liquor sold by the defendants. In my opinion the submission made has no merits. It is not necessary to establish actual confusion at the interim stage. At the interim stage merely likelihood of confusion is by itself sufficient for the purpose of grant of interim injunction. In any event I am of the opinion that by virtue of copying the label, the defendants are seeking to pass off the goods as belonging to the plaintiffs and thus it is necessary that the interim injunction should be granted in favour of the plaintiff. The last submission made by the learned counsel for the plaintiffs that they are also other user of the words ‘AirTel’ in the market. There is no material of any nature

whatsoever produced to show that infact the goods belonging to other persons are sold in the market under the brand name ‘AirTel’. The defendants have merely produced the list of pending application under the mark ‘AirTel’ with the Registry of Trade Marks. That by itself cannot show that other persons are using the word ‘AirTel’ in the market so as to deprive the plaintiff from obtaining interim injunction in the present case. In cases the user of the mark ‘AirTel’ by large number of persons in the market of different products it is required to show that infact goods are sold in the market under the brand name ‘AirTel’ so as to show that the plaintiffs cannot claim exclusive reputation in the said mark. Not a single case of sale has been shown by the defendant of any parties under the brand name ‘AirTel’. In that light of the matter the submission is required to be rejected.

29. However that is not an end of the matter. A very important factor in the present case is the fact that the defendant has failed to give any

satisfactory explanation for using the word mark ‘AirTel’. It is not only the words which are used by the defendant but even the the fonts style and the design of the label is also absolutely identical to that of the plaintiff. The fact that the plaintiff is the earlier holder of the said brand ‘AirTel’ with the said design and with the said get up is also not in dispute. Thus the plaintiff is the proprietor of the copy right of the label ‘AirTel’. The plaintiffs have designed the said label in 2002. The design which has been used by the defendant is on the whisky bottle is absolutely identical to the label design of the plaintiffs on their advertisements, catalogues, pamplets and T.V. commercials. The use of the word ‘AirTel’ is identical both by the plaintiffs and the defendants. I am inclined to accept the contention of the learned counsel for the plaintiffs that in the light of the provisions of Section 14, 51 and 55 of the Copy Right Act the plaintiffs are entitled to protect their label mark ‘AirTel’ as a prior holder of copy right and an author of the said artistic work. It has been

brought to my notice that the colour scheme used by the defendants in the label which has been used by the defendants for the whisky bottle is also identical to that of the plaintiffs herein. In view thereof it is undoubtedly correct that the use by the defendant of the said label with the identical font and identical mark is dishonest. The explanation given by the defendants for using the mark is that after drinking the whisky people fly in air and talk anything is merely required to be stated to be rejected. The contention is meritless. The use of the words 'AirTel' by virtue of the fact that they are using the same style, same colour scheme and similar labels leads to undisputed situation that the defendant is passing off the copy right work of the plaintiff by using the said label and thus the defendant must be stopped from using the said label with the identical mark 'AirTel' and in an identical artistic design and style.

30. I am also of the further opinion that the defendant no.1 should be prevented from using the

mark ‘AirTel’ because the defendant no.1 is only claiming to be the assignee of the said mark. The owner is defendant no.2. The defendant no.2 has not come forward to defend the mark which is owned by her though it is her creature. In my opinion if the defendant no.2 is not interested in defending her own mark the plaintiff cannot claim any right whatsoever to protect the said mark. I am also of the opinion that the fact that label is copied by the defendant no.2 is by itself enough to prevent the defendants from using the said mark ‘Airtel’ inrespect of the said labels and the said design. In that view of the matter I am of the opinion that the plaintiff is entitled to injunction in terms of prayer clause (a) and (c). Motion is accordingly made absolute in the aforesaid terms.

sd/-

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